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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,121	04/20/2005	Uwe Hering	449122080500	5812
25227 7590 03/07/2007 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			EXAMINER PHAN, THIEM D	
			ART UNIT 3729	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/532,121

Applicant(s)

HERING ET AL.

Examiner

Tim Phan

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 2/05/07 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed language "... provided in the sheath and/or the connection part ..." is confused and indefinite; it is unclear if, a casting channel is provided in both the sheath and the connection part or in the sheath only or in the connection part only.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by Luzzi (US 5,864,942).

**With regard to claim 10**, as best understood, Luzzi teaches a method for making high voltage switch or breaker pole (Fig. 1), comprising:

- producing a breaker (Fig. 1, 36) and a dimensionally stable sheath (Fig. 1, 42) independently from one another;
- fixing the breaker in the sheath (Col. 3, line 17)
- providing the cushioning (Fig. 1, 10; col. 6, lines 29-31) by filling the intermediate space with a fluid compensating compound; and
- curing (Col. 6, line 32) the compensating compound,
- wherein the intermediate space is filled with the fluid compensating compound (Col. 6, lines 29-31) via at least one casting channel (Fig. 1, 47 or 28 or 20) provided in the sheath and/or a connection part (Fig. 1, 58), each casting channel is arranged below the intermediate space when it is filled with the fluid compensating compound and the fluid compensating compound is introduced into the intermediate space under pressure or by

injection (Col. 6, line 29).

**With regard to claim 13**, Luzzi teaches that the connection part (Fig. 1, 58) is cast into the sheath (Fig. 1, 42) when the latter is produced.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luzzi.

**With regard to claims 11 and 12**, Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 10), which reads on applicants' claimed invention; except for having the casting channel sealed after filling with an insulating material.

It is mere matter of design choice to have the casting channel sealed after filling with an insulating material, since it is known in the art that the fluid compensating compound or insert has to be mold and cured (Col. 6, lines 30-32), which therefore sealed the casting channel and it appears that the invention would perform equally well with the molding and sealing process

taught by Luzzi.

8. Claims 1 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luzzi in view of Seki et al (US 5,698,008).

**With regard to Claim 1**, as best understood, Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 42) and applying a filling under some pressure (Col. 7, lines 33-37), comprising:

- producing a breaker (Fig. 1, 36) and a dimensionally stable sheath (Fig. 1, 42) independently from one another;
- fixing the breaker in the sheath (Col. 3, line 17)
- providing the cushioning (Fig. 1, 10; col. 6, lines 29-31) by filling the intermediate space with a fluid compensating compound; and
- curing (Col. 6, line 32) the compensating compound,
- wherein the intermediate space is filled with the fluid compensating compound (Col. 6, lines 29-31) via at least one casting channel (Fig. 1, 47 or 28 or 20) provided in the sheath and/or a connection part (Fig. 1, 58), each casting channel is arranged below the intermediate space when it is filled with the fluid compensating compound and the fluid compensating compound is introduced into the intermediate space under pressure or by injection (Col. 6, line 29); except for applying vacuum to fill the fluid compensating compound.

Seki et al teach a method of making vacuum valve by applying under vacuum atmosphere

and molding pressure in order to improve the withstand voltage characteristic.

It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the molding under vacuum and pressure, as taught by Seki et al, to the method of molding the fluid compensating compound or insert, as taught by Luzzi, in order to improve the withstand voltage characteristic of the insert.

**With regard to claims 6 and 7,** Luzzi in view of Seki et al teach a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Luzzi; Fig. 1, 10), which reads on applicants' claimed invention; except for having the casting channel sealed after filling with an insulating material.

It is mere matter of design choice to have the casting channel sealed after filling with an insulating material, since it is known in the art that the fluid compensating compound or insert has to be mold and cured (Col. 6, lines 30-32), which therefore sealed the casting channel and it appears that the invention would perform equally well by the molding and sealing process taught by Luzzi.

**With regard to Claim 8,** Luzzi teaches that the connection part (Fig. 1, 58) is cast into the sheath (Fig. 1, 42) when the latter is produced.

### ***Response to Arguments***

9. Applicants' arguments (filed on 2/05/07) with respect to claims 1, 6-8 and 10-13 have been considered but are moot in view of the new grounds of rejection.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M & Tu, 6AM - 2PM, and W & Th, 9AM – 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tim Phan  
Examiner  
Art Unit 3729

tp  
March 5, 2007